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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,672	12/12/2003	Scott W. Ziegler	INFAN-042A	6319

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STETINA BRUNDA GARRED & BRUCKER  
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ALISO VIEJO, CA 92656

EXAMINER
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HYLTON, ROBIN ANNETTE

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/734,672

Applicant(s)

ZIEGLER, SCOTT W.

Examiner

Robin A. Hylton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-19, drawn to a cap, classified in class 220, subclass 717.
  - II. Claims 20-25, drawn to a method for fastening a cap to a cup, classified in class 220, subclass 288.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the cap can be fastened to a cup (having no internal threads) by inserting the annular base into the cup and pressing the cap axially downward into the cup.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Lowell Anderson on June 3, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

5. Claims 3-5 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Specifically, the claims are rejected for the following reasons:

The language of claim 3 is awkward and confusing.

If it unclear how the lip is opposed the base when it is clearly shown in the drawing figures and set forth in claim 1 to be an extension of the base.

There is no structure set forth in the claims to allow for deformation of the cup walls without tearing the walls.

Dependent claims not specifically mentioned are rejected as depending from rejected base claims since they inherently contain the same deficiencies therein.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,3-5,9, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Marble (US 5,050,759).

The recess at the juncture of the downwardly depending base wall **26** and the lip **38** is considered to be “sized to engage” a bead of an associated cup during usage.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1 and 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marble in view of Ramsey (US 5,036,993).

Wherein the recess of Marble is not considered to be "sized to engage" a bead of an associated cup during usage, one of ordinary skill in the art would turn to the teaching of a lid having such a recess.

Ramsey teaches a lid having a recess "sized to engage" a bead of an associated cup during usage.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a recess "sized to engage" a bead of an associated cup during usage of the adaptor of Marble. Doing so allows the lid to effectively sealingly engage a rounded bead of an associated cup during use.

Regarding the taper at the distal end of the base wall, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make form the base wall with a taper at the distal end thereof and to form the taper of less than 5 degrees, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. Doing so allows the adaptor to be used with a cup having a downwardly tapered sidewall.

Regarding claim 8 and the number of threads, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select any number of threads expedient for forming and securing the adaptor to a cup.

Regarding claims 10 and 11 and the center of the recess, wherein the adapter is not associated with a specific cup, the center of the recess of the adaptor would be located either about the same radius or larger than the radius of a selected cup for use therewith.

10. Claims 12, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marble in view of Lin (US 6,752,287).

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Marble teaches the claimed adaptor except for the threads located on an insert.

Lin teaches it is known to provide an adaptor with an insert on the base wall, said insert having threads **42** extending therefrom.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of an insert on the base wall of Marble. Doing so provides a sealing member of softer material which more effectively seals an associated cup opening.

11. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Lin.

Marble as modified teaches the claimed adaptor except for the threads located on an insert.

Lin teaches it is known to provide an adaptor with an insert on the base wall, said insert having threads **42** extending therefrom.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of an insert on the base wall of Marble. Doing so provides a sealing member of softer material which more effectively seals an associated cup opening.

12. Claims 1,3-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamis (US 5,529,202) in view of Rees (US 6,745,915).

Shamis teaches a cap having a base **11** with equally spaced threads **19**, a spout **21** extending from the base, and a recess **39** for receiving a cup lip. The recess is not disclosed as receiving a cup lip having a bead thereon.

Rees teaches it is known to provide a cup having a rounded recess on the base for engaging a cup lip having a bead thereon.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a rounded recess for receiving a cup lip having a bead thereon. Doing so allows the cap to be used on alternative cup structures.

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As best claim 3 is understandable in view of the rejection under 35 USC 112, 2<sup>nd</sup> paragraph above, it is also obvious in view of the prior art of record.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Randolph (US D 476,849).

Shamis as modified teaches the claimed cap except for at least one handle extending from the cap.

Randolph teaches it is known to provide at least one handle extending from the cap.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further apply the teaching of at least handle extending from the cap of Shamis. Doing so allows for grasping and carrying the cap when associated with a cup to prevent condensation from getting on the user's hand.

14. Claims 1, 12, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwarz (US 4,574,970) in view of Bonwick (US 494,361).

Schwarz teaches the claimed cap except for the threads being formed on an annular insert fastened to the base and being made of a softer material than the base.

Bonwick teaches it is known to provide a cap having an annular insert fastened to the base and being made of a softer material than the base, the annular insert having threads formed thereon.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of an annular insert fastened to the base and being made of a softer material than the base, the annular insert having threads formed thereon. Doing so allows for secure engagement of the cap to various sized cup openings.

15. Claims 1 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agesen (US 4,810,245).

Agesen teaches the claimed cap except for threads on the base.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize threads on the base of Aagesen since the examiner takes Official Notice of the equivalence of threads and threadless, frictional engagement for their use in the closure art and the selection of any of these known equivalents to secure a cap to a cup would be within the level of ordinary skill in the art.

16. In view of the rejection under 35 USC 112, 2<sup>nd</sup> paragraph above, the patentability of claims 14-17 cannot be determined at this time.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various prior art closures teaching features similar to those disclosed and/or claimed are cited for their disclosures.

18. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the examiner.

19. It is called to applicant's attention that if a communication is faxed before the reply time has expired, applicant may submit the reply with a "Certificate of Facsimile" which merely asserts that the reply is being faxed on a given date. So faxed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence for Application Serial No. \_\_\_\_\_ is being facsimiled to The U.S. Patent and Trademark Office via fax number (703) 872-9306 on the date shown below:

Typed or printed name of person signing this certificate

\_\_\_\_\_

Signature \_\_\_\_\_

Date \_\_\_\_\_



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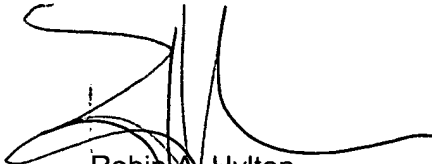
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robin Hylton whose telephone number is (571) 272-4540. The examiner can normally be reached Monday - Friday from 9:00 a.m. to 4:00 p.m. (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on (571) 272-4549.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Errica Miller at (571) 272-4370.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RAH  
June 6, 2005



Robin A. Hylton  
Primary Examiner  
GAU 3727